

NOV 23 2005

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571-273-8300	30
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	Appeal Brief

## NOTES/COMMENTS:

Re: Application No. 09/710,927

Inventor: Dutta

Title: Apparatus and Method for Keeping Aggregated Portions of Multiple Web Sites  
Simultaneously Displayed and Updated

Attached are the following:

- a. Appeal Brief;
- b. Transmittal Form; and
- c. Fee Transmittal

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PTO/SB/21 (09-04)

Approved for use through 07/31/2008. OMB 0651-0031  
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<b>TRANSMITTAL FORM</b>  <small>(to be used for all correspondence after initial filing)</small>	Application Number	09/710,927
	Filing Date	11/09/2000
	First Named Inventor	Orlita
	Art Unit	2174
	Examiner Name	Ke
	Attorney Docket Number	AUS920000616US1
Total Number of Pages in This Submission		

ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement  <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below).
Remarks Applicant is reinstating an appeal after the examiner reopened prosecution. New Appeal Brief is attached in compliance with MPEP 1204.01, the attached fee reflects the difference between the current fee and the amount previously paid (see MPEP1204.01).		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm Name	Slogosmund & Associates		
Signature	<i>Rudolf O. Siegemund</i>		
Printed name	Rudolf O. Siegemund		
Date	November 23, 2005	Reg. No.	37,720

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This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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NOV 23 2005

PTO/SB/17 (12-04v2)

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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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Effective on 12/08/2004.  
Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818)**FEE TRANSMITTAL**  
**For FY 2005**☐ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT** (\$) 170.00**Complete if Known**

Application Number	09/710,927
Filing Date	11/09/2000
First Named Inventor	Dutta
Examiner Name	Ke
Art Unit	2174
Attorney Docket No.	AUS920000616US1

**METHOD OF PAYMENT** (check all that apply)

- ☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): \_\_\_\_\_
- ☒ Deposit Account Deposit Account Number: 09-0447 Deposit Account Name: IBM Corporation
- For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)
- ☒ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee
- ☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments

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**FEE CALCULATION****1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

**2. EXCESS CLAIM FEES**

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180
<b>Total Claims</b>		
- 20 or HP = <u>0</u> x <u>0</u> = <u>0</u>		
HP = highest number of total claims paid for, if greater than 20.		
<b>Indep. Claims</b>		
- 3 or HP = <u>0</u> x <u>0</u> = <u>0</u>		
HP = highest number of independent claims paid for, if greater than 3.		

**3. APPLICATION SIZE FEE**

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

<b>Total Sheets</b>	<b>Extra Sheets</b>	<b>Number of each additional 50 or fraction thereof</b>	<b>Fee (\$)</b>	<b>Fees Paid (\$)</b>
- 100 = <u>0</u>	<u>0</u>	<u>0</u>	<u>0</u>	<u>0</u>

**4. OTHER FEE(S)**

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Appeal Brief

<b>Fees Paid (\$)</b>
170.00

**SUBMITTED BY**

Signature <u>Rudolf O. Siegesmund</u>	Registration No. (Attorney/Agent) <u>37,720</u>	Telephone <u>214-528-2407</u>
Name (Print/Type) <u>Rudolf O. Siegesmund</u>	Date <u>11-23-05</u>	

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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11/28/2005 EFLORES 00000097 090447 09710927  
 Sale Ref: 00000103 DWH: 090447 09710927  
 01 FC:1402 500.00-00

NOV 23 2005

**IN THE UNITED STATES PATENT & TRADEMARK OFFICE  
BOARD OF PATENT APPEALS & INTERFERENCES**

In re Dutta et al.,	) Serial No. 09/710,927
	)
Appellants,	) Docket No. AUS920000616US1
	)
For: Apparatus and Method for Keeping	) Art Unit 2174
Aggregated Portions of Multiple Web Sites	)
Simultaneously Displayed and Updated	) Examiner Ke
	)
Filed: 11/09/2000	)
	)

**Second Brief in Support of Appeal**

November 21, 2005

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

<p align="center">Certificate of Transmission</p> <p>I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. 571-273-8300) on <u>11/23/05</u>.</p> <p>Typed or printed name of person signing this certificate: <u>RUDOLF O. SIEGEMUND</u></p> <p>Signature: <u>Rudolf O. Siegemund</u></p>
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To the Honorable Commissioner for Patents:

Following the submission of a first appeal brief, the examiner of the pending application identified above reopened prosecution on the merits, and subsequently has rejected finally the appellant's claims set forth therein. The appellant has timely submitted a Notice of Appeal to the Board of Patent Appeals and Interferences, and now submits the following brief to support the appeal to the Board.

11/28/2005 EFLORES 00000103 090447 09710927

01 FC:1402 500.00 DA

Attorney Docket No. AUS920000616US1  
Serial No. 09/710,927  
Appeal Brief

### **I. REAL PARTY IN INTEREST**

The real party in interest in the present application is International Business Machines Corporation.

### **II. RELATED APPEALS & INTERFERENCES**

The appellant, the appellant's legal representative, nor the assignee has any knowledge of any application, patent, appeal, interference, or judicial proceedings which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

### **III. STATUS OF CLAIMS**

The application includes 16 claims. Claims 1-16 are pending. No claims have been withdrawn or allowed. The examiner has rejected all pending claims.

### **IV. STATUS OF AMENDMENTS**

All of the amendments have been entered in the present case.

### **V. SUMMARY OF CLAIMED SUBJECT MATTER**

The present invention is a GUI and software program that allows a user to create a new web page from existing web pages. The GUI comprises two sections: a split screen work area and a split screen canvas. The user invokes an existing web page in the split screen work area. The user then identifies an item of interest (information item) on the existing web page by drawing a circle around the information item. The present invention renders transparent the portion of the

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existing web page that is outside of the circle. Here, "transparent" means that the pixels of the web page are not displayed on the screen. The user then drags the existing webpage over to the split screen canvas and invokes a second web page in the split screen work area. The user repeats the procedure for the information unit in the second web page and places the second webpage over the first webpage. Because the information items are visible and the remainder of the webpage is transparent, the user only sees the information items. The user can rearrange the web pages on the split screen canvas to place the information items in any position desired by the user. All of the pixels from the existing web pages are captured in the new webpage. Thus, if a user wants to subsequently modify the information items, the user does not have to access the existing web pages a second time.

As recited in independent claim 1, the claimed subject matter is a method for displaying information items (page 5, line 1). The method comprises invoking a first web page (page 8, line 21); identifying a first information unit by creating a continuous line around a first information item on the web page (page 9, lines 7-9) so that the web page is divided into the first information unit and a first web page remainder (page 9, lines 13-17); rendering the first web page remainder transparent (page 9, lines 17-18); wherein the first web page is layered with a second web page comprising a second information unit and a second web page remainder (page 10, lines 12-14); and wherein the first information unit and the second information unit are visible through the transparent first web page remainder (page 8, lines 14-18; FIG. 3C)

As recited in independent claim 4, the claimed subject matter is a method for aggregating multiple information items on a display screen of a computer connected to the Internet. The method comprises displaying a multi-part graphical user interface (GUI) comprising a split

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screen work area and a split screen canvas (page 11, lines 13-14; FIG. 4); invoking a canvas web page in the split screen canvas (FIG. 4); invoking a first web page in the split screen work area (page 11, lines 14-15); identifying a first information unit on said first web page so that said first web page is divided into said first information unit and a first web page remainder (page 11, lines 15-17); rendering said first web page remainder transparent (page 11, lines 15-17); invoking a second web page (page 11, lines 20); identifying a second information unit on said second web page so that said second web page is divided into said second information unit and a second web page remainder (page 12, lines 1-2); rendering said second web page remainder transparent (page 12, lines 1-2); and wherein a user can simultaneously view the canvas web page and the first web page on the GUI (FIG. 5).

As recited in independent claim 10, the claimed subject matter is a programmable apparatus for display and simultaneous update of multiple information units. The programmable apparatus comprises a computer connected to a network; a display screen connected to the computer; a program installed on the computer; wherein the program contains instructions for displaying a multi-part graphical user interface (GUI) comprising a split screen work area and a split screen canvas (page 11, lines 13-14; FIG. 4), instructions for invoking a canvas web page in the split screen canvas (FIG. 4), instructions for invoking a first web page in the split screen work area (page 11, lines 14-15); wherein a user can simultaneously view the split screen work area and the split screen canvas (FIG. 5); wherein an information unit is identified on the first web page (page 11, lines 15-17); wherein the information unit is moved to the canvas web page (page 11, lines 17-18); wherein the first web page is layered with a second web page on the canvas web page, the second web page comprising a second information unit and a second web page remainder (page 10, lines 12-14); wherein the first web page remainder and the second web page remainder

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are rendered transparent (page 11, lines 14-16; page 12, lines 1-2); and wherein the first information unit and the second information unit are visible through the transparent first web page remainder and the transparent second web page remainder (page 8, lines 14-18; FIG. 5).

As recited in independent claim 13, the claimed subject matter is a computer readable memory for display and simultaneous update of multiple information units. The computer readable memory comprises a computer readable storage medium; a computer program stored in the storage medium; the storage medium, so configured by the computer program, causes a computer to display a multi-part graphical user interface (GUI) comprising a split screen work area and a split screen canvas (page 11, lines 13-14; FIG. 4), to invoke a canvas web page in the split screen canvas (FIG. 4), to invoke a first web page in the split screen work area (page 11, lines 14-15), to acquire a web page from the network and display said web page in a display screen (page 11, lines 14-15; FIG. 4), to identify an information unit on the web page (page 11, lines 15-17), to position the information unit on a canvas web page (page 11, lines 17-18), to acquire from the network a second web page (page 11, line 20), to identify a second information unit on the second web page (page 11, line 20 through page 12, line 2), to cause a first remainder of the first web page to be transparent (page 11, lines 14-16), to cause a second remainder of the second web page to be transparent (page 12, lines 1-2); wherein a user can simultaneously view the split screen work area and the split screen canvas (FIG. 5); and wherein the program is adapted for dragging the first information unit and the second information unit by a user (page 11, lines 17-18; page 12, lines 2-3), so that responsive to the dragging, said program positions the first information unit on the canvas web page and positions the second information unit on the canvas web page so that the canvas web page is visible through the first remainder and the



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second remainder and the first information unit is visible through the second remainder (page 8, lines 14-18; FIG. 5).

As recited in independent claim 14, the claimed subject matter is a computer implemented process to display and simultaneously update multiple information units. The computer implemented process comprises using a computer, performing the following series of steps: connecting the computer to at least one network; displaying a multi-part graphical user interface (GUI) comprising a split screen work area and a split screen canvas (page 11, lines 13-14; FIG. 4); invoking a canvas web page in the split screen canvas (FIG. 4); invoking a first web page in the split screen work area (page 11, lines 14-15); wherein a user can simultaneously view the split screen work area and the split screen canvas (FIG. 5); acquiring data in a data level; displaying the data level in a display frame in the first web page; identifying a first information unit on the first web page (page 11, lines 15-17).

## **VI. ISSUES ON APPEAL.**

### **A. Claim Rejections – 35 U.S.C. § 102**

Independent claim 14 is directed to a computer-implemented process, reciting the use of “a split screen work area and a split screen canvas” in “a multi-part Graphical User Interface (GUI).” Does Japanese Patent No. 11250054 [hereinafter Kosaka] disclose each and every element recited in claim 14, including the use of a split screen work area and canvas in a multi-part GUI?

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**B. Claim Rejections – 35 U.S.C. § 103**

1. Does the prior art upon which the examiner relies teach or suggest all of the limitations of claims 3-13, including the use of a split screen work area and canvas in a multi-part GUI?
2. Does the prior art upon which the examiner relies teach or suggest all of the limitations of claims 4-13, including the simultaneous viewing of components in a multi-part GUI?
3. Assuming *arguendo* that the prior art teaches or suggests all of the limitations in claims 1-13, has the examiner provided substantial evidence of a motivation to modify or combine the teachings of the prior art?

**VII. ARGUMENT**

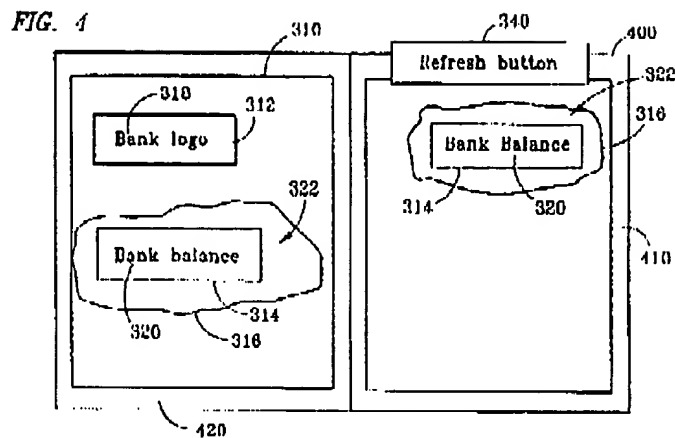
**A. Claim Rejections – 35 U.S.C. § 102 (Claims 14-16)**

“A claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987) (emphasis added). *See also* MPEP § 2131. Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

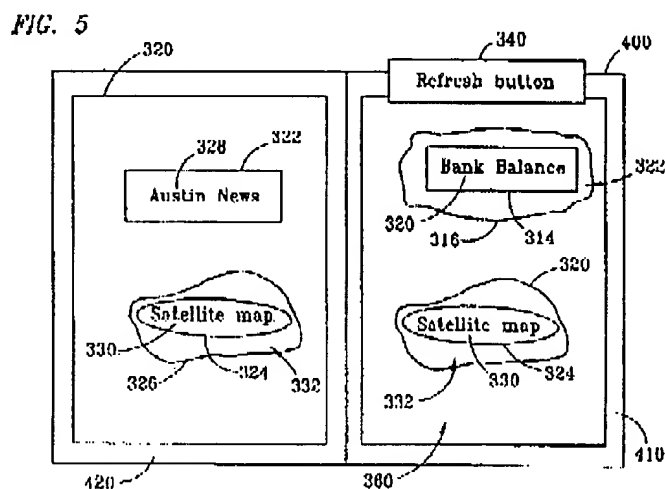
**1. Kosaka does not anticipate claims 14-16 under §102(b) because Kosaka does not disclose the use of a split screen work area and canvas in a multi-part GUI.**

The present invention discloses a multi-part GUI comprising a split screen work area and a split screen canvas. The split screen work area 420 and the split screen canvas 410 are shown below in Figures 4 and 5 of appellant’s Application.

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Application, Figure 4



Application, Figure 5

The split screen work area 420 and the split screen canvas 410 allow the user to see the new webpage 360 that the user is creating while simultaneously viewing existing web pages (310 in Figure 4, 320 in Figure 5). The user creates the new web page (canvas webpage 360) by invoking a first existing webpage 310 into the split screen work area 420. The user then identifies the desired information items 322 of the first existing web page 310 and renders the

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first existing webpage remainder transparent. After rendering the first existing web page remainder transparent, the user copies the first existing web page 310 (now comprising visible and transparent sections) onto the split screen canvas 410. The user then invokes a second existing web page 320 into the split screen work area 420, identifies the desired information items 332 of second existing web page 320, renders the remainder of the second existing web page transparent, and copies the entire second existing web page (now comprising visible and transparent sections) to the split screen canvas 410. Thus, the user can see the development of the newly created web page as the user identifies information items in the existing web pages, renders the remainder of the existing web pages transparent, and adds the existing web pages to the newly created webpage.

With respect to claim 14, the examiner states that

Kosaka teaches a computer-implemented process to display and simultaneously update multiple information units comprising:

...

displaying a multi-part graphical user interface (GUI) comprising a split screen work area and split screen canvas;

invoking a canvas web page in the split screen canvas (page 13, paragraph [sic] 2, 3, and 4);

*Examiner interprets extracting objects from first web page to be splitting the web page;*

invoking a first web page in the split screen work area;

wherein a user can simultaneously view the split screen work area and split screen canvas (page 13, paragraph [sic] 2, 3, and 4);

*Examiner interprets dividing the web pages into objects to be splitting web pages into multiple work area;*

...

(Office Action of 10/06/2005, at 2-3 (emphasis added).) The relevant passages of Kosaka, upon which the examiner relies, are quoted below:

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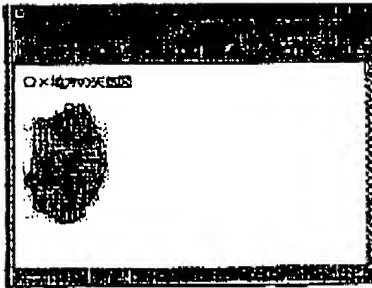
In Step S22, object extraction editor (4) in Figure 9 reads the two Web pages show in Figures 5 and 6, and in Step S23, it divides the Web pages into objects. HTML analysis engine (11) analyzes these following the rules in analysis rules DB (12). Figure 16 is a diagram showing the table contents of analysis rules DB (12). Following the analysis rules stored in the analysis rules DB in Figure 16, HTML analysis engine (11) divides objects into "graphics" parts as (231) in Figure 17 and "table" parts as (233) in Figure 18. In this example, Figures 17 and 18 are diagrams showing the sources for the original Web pages in Figures [sic] 5 offering weather information and Figure 6 offering lodging information.

Analysis rules DB (12) in Figure 16 is comprised of the object type, header anchor tag, and footer anchor tag. In the case of object type (223) in Figure 16, a header anchor tag such as "<p><image src=" (224) and a footer anchor tag "></p>" such as (225) are stored in analysis rules DB in Figure 16. In the case of table object type (226), a header anchor tag such as "<table" (227) and a footer anchor tag such as "<table>" (228) are stored. The above-mentioned "<p><image src=" (224) and "></p>" (225) correspond to (231) in Figure 17, and the above mentioned "<table" (227) and "<table>" (228) correspond to (235) and (234) within (233) in Figure 18.

In Step S24, the divided object is sent to object package part (13). In step S25, the user revises the weather map in object package part (13) to one object called "Weather Map of OX Region", and likewise revises the lodging reservation table to one object called "Lodging Reservation Status" (232). In Step S26, the user checks whether the dividing method is correct. If the dividing method is correct, the Web page is sent to Web page generation editor (5) shown in Figure 10. Kosaka, p. 13, paragraphs 2-4.

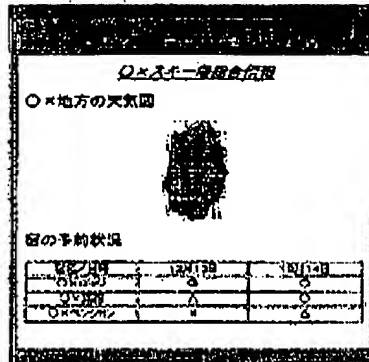
Kosaka's figures 5, 6, and 7 are also shown below:

【図5】



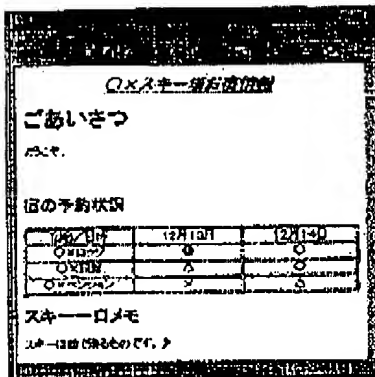
Kosaka, Figure 5

【図7】



Kosaka, Figure 7

【図6】



Kosaka, Figure 6

Under the anticipation standard set forth above, Kosaka must identically show all of the elements in the claim. Thus, if Kosaka fails to show a multi-part GUI comprising a split screen work area and split screen canvas, then Kosaka cannot anticipate appellant's claims 14-16.

Kosaka does not anticipate claims 14-16 because Kosaka does not show a multi-part GUI comprising a split screen work area and split screen canvas. Kosaka discloses a first existing web page in figure 5 and a second existing web page in figure 6. Kosaka discloses the newly created web page in figure 7. Kosaka does not teach the use of a multi-part GUI to create the new web page. As Kosaka describes in paragraph 2 of page 13 and in figure 9, an "object extraction editor (4)" reads the first web page and the second web page and "divides the [w]eb pages into objects." That is, Kosaka programmatically divides the web pages into data objects – not visual information units as appellant claims. Kosaka's does not disclose that the object extraction editor implements any type of GUI, much less a multi-part GUI. Likewise, Kosaka does not disclose a GUI that allows the user to simultaneously view an existing web page and a newly created web page. Thus, Kosaka cannot anticipate claims 14-16 because Kosaka does not disclose a multi-part GUI having a split screen work area and a split screen canvas that allows a user to simultancously view an existing web page and a newly created web page.

**2. The examiner's interpretation of Kosaka is inapplicable to claims 14-16.**

As quoted above, though, the examiner interprets Kosaka's extraction of objects from a first web page to be "splitting the web page." Assuming *arguendo* that the examiner's

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“interpretation” is accurate, it is wholly inapplicable to claims 14-16 because the relevant elements of appellant’s claim are not directed to “splitting the web page.” The elements to which the examiner appears to apply this interpretation read, “displaying a multi-part graphical user interface (GUI) comprising a split screen work area and split screen canvas; [and] invoking a canvas web page in the split screen canvas . . .” “Splitting the web page” is completely foreign to these elements. The examiner appears to be improperly and simultaneously conflating the term “web page” with both a “split screen work area” and a “split screen canvas.” It is improper because the language “invoking a canvas web page *in* the split screen canvas” (emphasis added) clearly demonstrates the appellant’s intent to differentiate between the term “web page” and the term “split screen canvas.” Moreover, the terms “split screen work area” and “split screen canvas” clearly refer to two distinct and separate items. Thus, even if it was proper to equate the term “web page” with one of the terms, it certainly would not be proper to equate “web page” with *both* terms. The examiner further misapplies an almost identical interpretation to subsequent elements in claim 14.

Accordingly, the appellant submits that claims 14-16 recite differences between the appellant’s claimed subject matter and Kosaka’s teachings and the Board should reverse the examiner’s rejection of these claims.

#### **B. Claim Rejections – 35 U.S.C. § 103**

An applicant’s claimed invention may be unpatentable under 35 U.S.C. § 103 if it would have been “obvious” to a person of ordinary skill in the art to modify or combine the prior art in order to meet the claims, even if a single reference does not anticipate the claimed invention. *See* 35 U.S.C.S. § 103(a); *Beckson Marine v. Nfm, Inc.*, 292 F.3d 718,

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727 (Fed. Cir. 2002) (stating that “obviousness may render a claimed invention invalid where the record contains a suggestion or motivation to modify the prior art teaching to obtain the claimed invention,” even if the prior art does not “reach expressly each limitation exactly”); *Hartness Int’l, Inc. v. Simplimatic Eng’g Co.*, 819 F.2d 1100, 1108 (Fed. Cir. 1987) (“the inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed”). “Obviousness” is a legal conclusion based on underlying findings of fact.<sup>1</sup> *In re Peterson*, 315 F.3d 1325, 1328 (Fed. Cir. 2003). The underlying factual inquiry includes determining “the scope and content of the prior art;” ascertaining the “differences between the prior art and the claims at issue;” and resolving “the level of ordinary skill in the pertinent art.” *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966); *In re Zurko*, 258 F.3d 1379, 1383-84 (Fed. Cir. 2001).

The examiner, though, carries the initial burden of establishing a *prima facie* case of obviousness before rejecting a claimed invention under 35 U.S.C. § 103. *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998); *In re Alton*, 76 F.3d 1168, 1175 (Fed. Cir. 1996); *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992); *In re Wertheim*, 541 F.2d 257, 263 & 265 (C.C.P.A. 1976); *MPEP* § 2141, 2142, 706.02(j); *see also* 35 U.S.C.S. § 132. To establish *prima facie* obviousness of a claimed invention, the examiner must demonstrate with substantial evidence that all the claim limitations are taught or suggested by the prior art. *See, e.g., In re Zurko*, 258 F.3d at 1384-85 (holding invention was not obviousness because prior art failed to teach single element); *In re Grasselli*, 713 F.2d 731 (Fed. Cir. 1986) (finding that prior art was deficient in at least one element – the claimed invention

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<sup>1</sup> Legal conclusions of obviousness are reviewed de novo, while the underlying factual conclusions are reviewed for substantial evidence. *In re Peterson*, 315 F.3d 1325, 1328 (Fed. Cir. 2003).

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could not have been obvious without motivation to add element); *accord MPEP* § 2143.03 (citing *In re Royka*, 490 F.2d 981 (CCPA 1974)).

But most, if not all, inventions arise from a combination of old elements. *In re Kotzab*, 217 F.3d 1365, 1369 (Fed. Cir. 2000) (citing *In re Rouffet*, 149 F.3d at 1357). “Thus, every element of a claimed invention may often be found in the prior art” and the examiner must consider the claimed invention as a whole. *Id.* at 1369-70; *accord MPEP* § 2141.02. “[I]dentification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention.” *Kotzab*, 217 F.3d at 1370. The examiner may not evaluate the invention “part by part,” using the invention as a “roadmap to find its prior art components.” *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1337 (Fed. Cir. 2005).

Accordingly, there must be some motivation, suggestion or teaching of the desirability of making the specific combination to establish obviousness based on a combination of the elements disclosed in the prior art. *Princeton Biochemicals*, 411 F.3d at 1337; *Kotzab*, 217 F.3d at 1370; *accord MPEP* § 2143.01. Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. *Kotzab*, 217 F.3d at 1370. The teaching, suggestion, or motivation must be found either explicitly or implicitly in the references themselves, in the nature of the problem to be solved, or in the knowledge generally available to one of ordinary skill in the art. *Beckson Marine*, 292 F.3d at 728 (citing *Rouffet*, 149 F.3d at 1357). It is the duty of the examiner to identify the source of the motivation, and to explain why the combination of the teachings is proper. *Rouffet*, 149 F.3d at 1356-57; *In re Fitch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (“The mere fact

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that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification"). Hindsight reconstruction is impermissible. *Id.*

**1. The examiner has failed to establish *prima facie* obviousness because the prior art cited by the examiner does not teach all of the claimed limitations.**

**a) The prior art cited by the examiner does not teach a multi-part GUI having split screen work area and canvas (claims 3-13).**

The examiner has rejected claims 3-13 as unpatentable over Kosaka in view of other references. (Office Action of 10/06/2005, at 4-13.) As discussed in detail above in response to the examiner's § 102 rejections, Kosaka fails to disclose a multi-part GUI comprising a split screen work area and split screen canvas. The examiner has cited no other art as disclosing this limitation. The appellant, though, recites this limitation in each of independent claims 4, 10, and 13, as well as dependent claim 3. Accordingly, the prior art fails to teach all of the limitations in these claims. And since a dependent claim necessarily incorporates all of the limitations of the claim upon which it depends, the prior art *ipso facto* fails to teach all of the limitations in claims 5-9 and 11-12.

**b) The prior art cited by the examiner does not teach a system wherein a user can simultaneously view the components of the multi-part GUI (claims 4-13).**

The examiner also has rejected claims 4-13 as unpatentable over Kosaka in view of other references. (*Id.*) As discussed in detail above in response to the examiner's § 102 rejections, Kosaka fails to disclose a system wherein a user can simultaneously view more than one component of a multi-part GUI. The examiner has cited no other art as disclosing this limitation. The appellant, though, recites this limitation in each of independent claims 4, 10, and 13. Accordingly, the prior art fails to teach all of the

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limitations in these claims. And since a dependent claim necessarily incorporates all of the limitations of the claim upon which it depends, the prior art *ipso facto* fails to teach all of the limitations in claims 5-9 and 11-12.

**2. The examiner has failed to provide substantial evidence of the alleged motivation to modify or combine the teachings of the prior art, which is required to establish *prima facie* obviousness (claims 1-13).**

Assuming *arguendo* that the prior art cited by the examiner does, in fact, teach all of the limitations in claims 1-13, the examiner nonetheless must demonstrate some motivation, suggestion or teaching of the desirability of making specific combinations of prior art to establish obviousness based on a combination of the elements disclosed in the prior art. *Princeton Biochemicals*, 411 F.3d at 1337; *Kotzab*, 217 F.3d at 1370; accord *MPEP* § 2143.01. An alleged suggestion or motivation to modify the teaching of the prior art must be supported by particular findings and substantial evidence. *Kotzab*, 217 F.3d at 1370 & 1371. Substantial evidence is something less than the weight of the evidence but more than a mere scintilla of evidence. *Kotzab*, 217 F.3d at 1369. Broad conclusory statements of suggestion or motivation standing alone are not "evidence." *Id.* at 1370.

Here, the examiner has provided only broad, conclusory statements regarding the motivation or suggestion to modify Kosaka in a manner that would render obvious claims 1-13. With respect to independent claims 1, 4, 10, and 13, for example, the examiner concedes that Kosaka fails to teach rendering parts of a web page transparent, but cites U.S. Patent No. 6,493,744 [hereinafter Emens] as teaching this element. The examiner states only that "[i]t would have been obvious . . . to include Emens' teaching with the method of Kosaka in order to allow users to view the undesired portion later if they

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choose to.” (Office Action of 10/06/2005, at 5, 7, 8, & 13.) The examiner has not provided any particular findings to explain why the combination is proper, nor has the examiner identified the *source* for the alleged motivations. *Rouffet*, 149 F.3d at 1356-57; *Fitch*, 972 F.2d at 1266. Accordingly, the examiner’s broad statements cannot stand as evidence. Without particular findings, the Board should infer that the examiner “fell into the hindsight trap.” *Kotzab*, 217 F.3d at 1371; *Rouffet*, 149 F.3d at 1358.

**3. The examiner has impermissibly evaluated the appellant’s claims “part by part,” using the appellant’s claims as a “roadmap to find its prior art components” (claims 1-13)**

Finally, the Board should reverse all of the examiner’s rejections under § 103 as improper because the examiner has impermissibly evaluated the appellant’s claims part by part. Assuming *arguendo* again that the prior art does, in fact, teach all of the limitations in claims 1-13, the prior art nonetheless fails to defeat patentability of the “whole claimed invention.” *Kotzab*, 217 F.3d at 1370. The examiner may not evaluate the invention “part by part,” using the invention as a “roadmap to find its prior art components.” *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1337 (Fed. Cir. 2005). The examiner *must* consider the claimed invention as a whole. *Kotzab*, 217 F.3d at 1369-70; *accord* MPEP § 2141.02.

Here, the examiner appears to be evaluating the appellant’s claims word by word, without any consideration or thought to the context of those words – much less the invention as a whole. This tactic clearly is impermissible and should not be condoned by the Board. *See Princeton Biochemicals*, 411 F.3d at 1337.

### VIII. CONCLUSION

Clearly, Kosaka does not disclose "each and every" element set forth in independent claim 14, much less in "as complete detail as is contained in the claim." *Richardson*, 868 F.2d at 1236. Among other things, Kosaka does not disclose a multi-part GUI comprising a split screen work area and split screen canvas. Moreover, Kosaka does not disclose a computer-implemented process wherein a user can simultaneously view the canvas web page and the first web page on the GUI. Since Kosaka does not disclose these limitations in independent claim 14, it cannot anticipate this claims under 35 U.S.C. § 102. And to the extent that Kosaka cannot anticipate the independent claim, it cannot anticipate any claim that depends upon the independent claim.

With respect to the examiner's rejection of claims 1-13 under § 103, the prior art upon which the examiner relies fails to teach or suggest all of the limitations in the appellant's claimed invention. The examiner has failed to properly identify the source of the motivation, if any, and to explain why the combination of the teachings in the prior art is proper. Without such support, the examiner presumably has engaged in impermissible hindsight reconstruction of the appellant's invention. Accordingly, the examiner's rejections of these claims under § 103 is improper and the Board must reverse these rejections.

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For the foregoing reasons, the appellant submits that the claims of the present application are not fairly taught by any of the references of record, taken either alone or in combination. Therefore, allowance of the present application is in order, and the appellant respectfully requests the Board to reverse the examiner's rejections.

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## **IX. CLAIMS APPENDIX**

The text of the claims involved in the appeal is:

1. A method for display of one or more information items comprising the steps of:
  - invoking a first web page;
  - identifying a first information unit by creating a continuous line around a first information item on said web page so that said web page is divided into said first information unit and a first web page remainder;
  - rendering said first web page remainder transparent;
  - wherein the first web page is layered with a second web page comprising a second information unit and a second web page remainder; and
  - wherein the first information unit and the second information unit are visible through the transparent first web page remainder.
2. The method of claim 1 further comprising:
  - invoking the second web page;
  - identifying the second information unit by creating a continuous line around a second information item on said second web page so that said second web page is divided into said second information unit and a second web page remainder;
  - rendering said second web page remainder transparent;
  - positioning said second information unit relative to said first information unit by dragging; and
  - wherein the first information unit and the second information unit are visible through the transparent second web page remainder.



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3. The method of claim 1 further comprising:

displaying a multi-part graphical user interface (GUI) comprising a split screen work area and a split screen canvas;

dragging said first information unit to a canvas web page;

positioning said first information unit on the canvas web page;

wherein the canvas web page is located on the split screen canvas; and

wherein the first web page is located on the split screen work area.

4. A method for aggregating multiple information items on a display screen of a computer connected to the internet comprising the steps of:

displaying a multi-part graphical user interface (GUI) comprising a split screen work area and a split screen canvas;

invoking a canvas web page in the split screen canvas;

invoking a first web page in the split screen work area;

identifying a first information unit on said first web page so that said first web page is divided into said first information unit and a first web page remainder;

rendering said first web page remainder transparent;

invoking a second web page;

identifying a second information unit on said second web page so that said second web page is divided into said second information unit and a second web page remainder;

rendering said second web page remainder transparent; and

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wherein a user can simultaneously view the canvas web page and the first web page on the GUI.

5. The method of claim 4 further comprising dragging said first information unit to said canvas web page and positioning said first information unit on the canvas web page.
6. The method of claim 4 further comprising dragging the second information unit to said canvas web page and positioning the second information unit on the canvas web page.
7. The method of claim 4 further comprising saving said canvas web page, said first information unit, and said second information unit as a composite web page.
8. The method of claim 4 further comprising: updating said first information unit.
9. The method of claim 4 further comprising: updating said second information unit.
10. A programmable apparatus for display and simultaneous update of multiple information units comprising,  
programmable hardware comprising:
  - a computer connected to a network;
  - a display screen connected to said computer;
  - a program installed on said computer;

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wherein responsive to said program contains instructions comprising:  
instructions for displaying a multi-part graphical user interface (GUI)  
comprising a split screen work area and a split screen canvas;  
instructions for invoking a canvas web page in the split screen canvas;  
instructions for invoking a first web page in the split screen work area;  
wherein a user can simultaneously view the split screen work area and the  
split screen canvas;

wherein an information unit is identified on the first web page;  
wherein said information unit is moved to the canvas web page  
wherein the first web page is layered with a second web page on the canvas  
web page, the second web page comprising a second information unit and a second  
web page remainder;

wherein the first web page remainder and the second web page remainder are  
rendered transparent; and

wherein the first information unit and the second information unit are visible  
through the transparent first web page remainder and the transparent second web page  
remainder.

11. The programmable apparatus of claim 10 wherein said information unit is identified  
by creating a continuous line around the information item on said web page so that  
said web page is divided into said information unit and a remainder; and said  
remainder is rendered transparent.

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12. The programmable apparatus of claim 10 wherein a second web page is acquired from said network and a second information unit is identified from the second web page;

wherein a first web page remainder of said first web page is rendered transparent;

wherein a second web page remainder of said second web page is rendered transparent;

wherein said first information unit is positioned on said canvas web page and said second information unit is positioned on said canvas web page so that said canvas web page is visible through said first web page remainder and said second web page remainder; and

wherein said first information unit is visible through said second web page remainder.

13. A computer readable memory for display and simultaneous update of multiple information units comprising:

a computer readable storage medium;

a computer program stored in said storage medium;

the storage medium, so configured by said computer program, causes the computer;

to display a multi-part graphical user interface (GUI) comprising a split screen work area and a split screen canvas;

to invoke a canvas web page in the split screen canvas;

instructions for invoking a first web page in the split screen work area;  
to acquire a web page from said network and display said web page in  
a display screen;  
to identify an information unit on the web page;  
to position said information unit on a canvas web page;  
to acquire from said network a second web page;  
to identify a second information unit on the second web page;  
to cause a first remainder of said first web page to be transparent;  
to cause a second remainder of said second web page to be transparent;  
wherein a user can simultaneously view the split screen work area and  
the split screen canvas; and  
wherein said program is adapted for dragging of said first information  
unit and said second information unit by a user, so that responsive to said  
dragging, said program positions said first information unit on said canvas  
web page and positions said second information unit on said canvas web page  
so that said canvas web page is visible through said first remainder and said  
second remainder and said first information unit is visible through said second  
remainder.

14. A computer implemented process to display and simultaneously update multiple  
information units comprising:

using a computer, performing the following series of steps:  
connecting said computer to at least one network;

displaying a multi-part graphical user interface (GUI) comprising a split screen work area and a split screen canvas;  
invoking a canvas web page in the split screen canvas;  
invoking a first web page in the split screen work area;  
wherein a user can simultaneously view the split screen work area and the split screen canvas;  
acquiring data in a data level;  
displaying said data levels in a display frame in the first web page;  
identifying a first information unit on said first web page.

15. The computer implemented process of claim 14 further comprising: using a computer, updating said data level.

16. The computer implemented process of claim 14 further comprising:  
using a computer performing the following steps,  
invoking a canvas web page;  
positioning said first information unit on said canvas;  
invoking a second web page;  
identifying a second information unit on said second web page; and  
positioning said second information unit on said canvas web page.